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09/434,645	11/05/1999	DAVID B. LOEPER	D5009-00002	4199

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EXAMINER
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KYLE, CHARLES R

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 12/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/434,645

Applicant(s)

LOEPER, DAVID B.

Examiner

Charles R Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The rejection of Claims 2, 8 and 14 is withdrawn based on Applicant's amendment.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite no feature that places the claimed inventions within the technological arts. No particular technological element such as a computer is claimed. Specifically, the method claims as presented do not claim a technological basis in the pre-amble or body of the claim. Without a claimed technological basis, the claim may be interpreted in an alternative as involving no more than manipulation of an abstract idea and is therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim at least one structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61USPQ2d 1660, 1671 (Bd. Pat. App. & Inter. 2001) – used only for content and reasoning since not precedential).

The rejection of Claims 1-21 as rejected under 35 U.S.C. 101 because the claimed invention lacked patentable utility is withdrawn based on Applicant's amendment.

***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Jones et al* in view of *Jones et al* in view of *Birwirth et al*, both of record.

**As to Claim 1**, *Jones* discloses the invention substantially as claimed as in a method for evaluating financial plans (Abstract) the steps of:

Receiving from a user financial plan information, comprising a predetermined initial value of an investment (Col. 18, lines 27-29), at least one predetermined contribution amount at a predetermined contribution time (Col. 18, line 21 and Col. 18, lines 43-48), at least one predetermined withdrawal amount at a predetermined withdrawal time subsequent to the predetermined contribution time (Col. 22, lines 56-60) and a plan duration (Col. 17, line 36-43 and Col. 18, lines 27-28);

Presenting calculated investment values using results of said steps (Col. 20, lines 7-30).

*Jones* does not specifically disclose the detail of simulating historical performance of a portfolio to analyze financial plans. *Birwirth* discloses these particular features as follows:

Selecting a first historical commencement date for a simulation of performance of a financial plan consistent with financial plan information (Page 3, lines 24-26);

Using historical market data commencing from said first historical commencement date, calculating the changes in said predetermined initial value of an investment for each time period in one or more series of successive historical time periods including allowing for said predetermined contribution amount and said predetermined withdrawal amount continuing until an expiration of the plan duration (Page 3, lines 35-38); and

Selecting a plurality of second historical commencement dates and repeating the foregoing steps of calculation commencing with each of said second historical commencement dates (Page 3, lines 29-32).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the financial plan analysis of *Jones* with the historical analysis of *Birwirth* because of the improved performance resulting from this historical approach. These benefits are specifically set out by *Birwirth* as follows. *Birwirth* describes problems with unrealistic assumptions of traditional financial plans at the last paragraph of page 1 and describes the solution to this problem as using the historical investment experience of others to produce more realistic and useful retirement modeling. See particularly the Conclusion at page 6 of *Birwirth*.

Additionally, the steps of receiving and allowing for initial investment, contributions, withdrawals and a plan duration cannot confer patentability because they replicate the steps involved in the retirement ledger disclosed by *Birwirth* at page 1, line 16 to page 2, line 51. The concepts recited here are similar to those of another well-known financial activity, balancing a checkbook at the end of the month.

**Regarding Claims 3, 9 and 15,** *Bierwirth* discloses the invention substantially as claimed. See the discussions set forth above. *Bierwirth* does not specifically disclose allocation to more than one asset category. Jones et al disclose multiple asset categories and distinct historical data at Fig. 4 and Col. 12, line 54 to Col. 13, line 41. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the multiple asset categories of *Jones* in the invention of *Bierwirth* because this would have allowed investors to flexibly study varying combinations of investments in an attempt to maximize return on investment.

**As to Claims 4, 10 and 16,** *Bierwirth* disclose comparison of results of calculation to a goal at page 2, lines 31-41.

**Concerning Claims 5, 11 and 17,** Jones discloses adjustment for taxes at Fig. 3 and Col. 8, lines 1-13. Also, *Bierwirth* discloses adjustment for taxes at pages 5-6, "A Word About Taxes".

**With respect to Claims 6, 12 and 18,** Jones et al teach the entry of initial investment values and allocation to asset categories at Col. 5, line 50 to Col. 7, line 10.

**With respect to Claims 7 and 13,** *Bierwirth* discloses the use of a computer system, which inherently uses a storage medium for executable instructions. See *Bierwirth* at page 3, lines 7-9.

Additionally, the steps of receiving initial investment, contributions, withdrawals and a plan duration cannot confer patentability because they replicate the steps involved in the

retirement ledger disclosed by *Bierwirth* at page 1, line 16 to page 2, line 51. The concepts recited here are similar to those of another well-known financial activity, balancing a checkbook at the end of the month.

**As to Claim 19**, *Bierwirth* discloses identification of time intervals at result presentation at page 3, lines 21-33.

**Concerning Claim 20**, *Bierwirth* discloses having as a goal a specified sum after a number of years at page 2, lines 31-35.

**Regarding Claim 21**, Jones et al disclose changing an asset allocation after a selected number of time intervals and using a changed allocation in subsequent calculations at Col. 12, lines 24-28.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-21 have been considered but are persuasive.

At page 7 of the response, Applicant argues that *Birwirth* lacks particular features; the Examiner disagrees but additionally relies on *Jones* for these features.

At page 7, last paragraph, Applicant implies that his predetermined withdrawal amounts differ from the steady income amounts of *Birwirth*, but does not state how. There is no claim language which requires that the predetermined withdrawal amounts vary. Thus, *Birwirth* discloses predetermined withdrawal amounts.

At the second full paragraph of page 8, Applicant asserts a benefit of his invention as being "realistic", a desirable but vague description.

At page 8 onto 9, Applicant asserts flexibility of his plan, allowing for instance, a range of possible ending balances. This is, among other features argued, unclaimed.

At the first full paragraph of page 9, Applicant again argues that by providing for level income, no predetermination is made of withdrawal amounts in *Birwirth*. The Examiner notes that the predetermined withdrawal amount is a predetermined level income in *Birwirth*.

Throughout remarks, Applicant suggests that his invention provides flexibility of considering variables such as saving, retirement age and reducing withdrawals. *Albright et al* is cited but not relied upon for rejection to show that consideration of variables for flexibility was old and well known at the time of invention.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles R Kyle whose telephone number is (703) 305-4458. The examiner can normally be reached on M-F 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A. Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

*CRK*

crk

December 2, 2003

*Vincent Millin*

VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
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